REMARKS

Status of the Application

Claims 1,4,5,8 and 17-25 are all the claims pending. Claims 1,4,5,8 and 17-21 are rejected. Claims 22-25 are new.

Claim Rejections - 35 U.S.C. § 102

Claims 1,4,5,8 and 17-21 are rejected under 35 U.S.C. 102(e) as being anticipated by Nihei (U.S. Patent Number 6,891,634).

The Applicant thanks the Examiner for an interview conducted on June 11, 2008. In the interview, Examiner and Counsel for Applicant discussed the pending claim rejections, particularly the "selection process means for selecting one or more of the composite image, original images, or combining data as output data based on an output destination device specified as the destination for image transmission" recited in claim 1, with a similar recitation in independent claim 5. The Examiner explained that this feature is disclosed in Nihei in that image print jobs are assigned to printers based on the capacity of the printer, and so long any composite image or any original image is selected to go to a printer, then this claim element is met.

Counsel for Applicant responded that the selection of any composite or original image does not meet this requirement, as these terms have antecedent basis in the claim, and refer back to "the composite image generated by the combining process means", "the original images that the composite image comprises", and "corresponding combining data required for generating the composite image", respectively. That is, the selection process is not the selection of any composite image or any original image, but is a selection among a composite image, original images for that composite image, and combining data for generating that composite image. There

is no disclosure of such a selection process means in Nihei. The system does not select a composite image or original images to be sent based on the output destination device. As explained in Nihei, column 5, line 50, to column 6, line 25, the decision whether us a template (which, when combined with the image, is what the Examiner interprets as corresponding to the recited "composite image") is made by the user, e.g., "If the user selects "NO BACKGROUND IMAGE", the template image selection processing is skipped" (column 6, lines 2-4). As explained in column 6, lines 26 to 52, the images to be printed are also selected by the user. Thus Nihei does not disclose a selection process means that chooses from among to "the composite image generated by the combining process means", "the original images that the composite image comprises", and "corresponding combining data required for generating the composite image" as output data. In fact, the process of Nihei is better understood as not disclosing a process for selecting output data at all, but rather as disclosing a process for selecting a printer for print jobs already selected by the user. A printer is examined for capacity and capability and if such criteria are met, the data can be sent. Thus, a printer is selected based on the composite image data. This is the opposite of the selection of claim 1, wherein output data is selected based on a destination.

Agreement was not reached, as the Examiner stated that he would have to review the reference in detail. Applicant respectfully requests the Examiner, if he believes that Nihei does disclose the recited feature, to explain in detail how it is disclosed, preferably with quotations or pinpoint citations of the text of the reference, and to explain any disagreements he may have with the explanation of the reference provided here.

We would point out that the Examiner's rejection does not explain sufficiently why the disclosure of Nihei includes all the claim recitations. For example, though the Examiner cites

column 8, lines 31-59 to teach a storing means, there is no reason why the storing devices of Nihei teaches storing the forms of image information including 1) the original images; 2) the composite image and 3) the combining data. For example, the DRAM 14 includes only composite data. A frame memory 6 includes, at best, only original data. No memory holds all three forms. Furthermore, the frame memory of Nihei is clearly not equivalent to the hard disks and other physical devices given as exemplary embodiments of the storage means in the specification, which are for long term storage. The frame memory and DRAM of Nihei, which are volatile and not appropriate for long term storage. Because "storage means" is recited in means plus function language, "an examiner carries the initial burden of proof for showing that the prior art structure or step is the same as or equivalent to the structure, material, or acts described in the specification which has been identified as corresponding to the claimed means or step plus function" (MPEP 2182).

Additionally, Applicant submits that there is no combining data recited in Nihei. In the interview, the Examiner pointed to the "composite image data" disclosed in Nihei, column 8 lines 39-40 and 54. However, the Applicant submits that the composite image data is the composite image itself, not the recited combining data: "the image represented by the print image data is combined with the image represented by the template image data to generate composite image data" (column 8 lines 37-40); "when the composite image data is transferred to the idle printer, data indicative of a print command is transmitted to the printer to which the composite image data was transferred and print processing is executed" (column 8, lines 53-55). If the Examiner believes that the recited combining data is inherent in Nihei or otherwise disclosed, he is respectfully invited to fully explain how he believes this to be so. To the extent

that the Examiner contends that there is an inherent storage of all three forms, such are not stored in the recited storage means of claim 1.

Applicant thus respectfully submits that claims 1 and 5 are patentable over Nihei at least due to these differences. The remaining claims are patentable at least due to their dependencies.

Claims 18 and 19

All three forms of image are further not stored in a single storage device (claim 18) or in a hard disk (claim 19). The Office Action states that the "storage means" being a single physical memory, as recited in claim 18, "reads on different memories depicts in figure 5" (Office Action, page 4). However, column 8, lines 31 to 41, clearly show that the image and template are stored in frame memory 6, and composite image data is stored in working DRAM 15. The Examiner points to element 36 of figure 5 as the hard disk recited in claim 19, even though there is no disclosure of this device performing the functions recited for the storage means in the claims.

New Claims

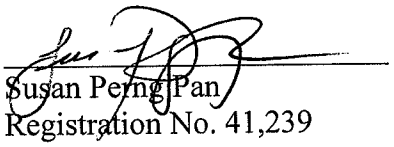
Claims 22-25 are new. Claims 22-24 are patentable due to their dependencies. Claim 25 recites a selection process means similar to that analyzed above, and is thus patentable at least for that reason.

Conclusion

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880 via EFS payment screen. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,



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